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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/926,872    09/10/97    SULLIVAN

M    SLD2121

EXAMINER

QM12/0910

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MARLO, G

ART UNIT

PAPER NUMBER

3711

*10*

DATE MAILED:

09/10/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/926872

Applicant(s)

Sullivan et al

Examiner

George J. MARLO

Group Art Unit

3711

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on July 16, 1999
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1 + 3-8 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1 + 3-8 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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In the amendment filed July 16, 1999, the "substitute drawings" referred to on page 4, line 4, cannot be found in the file.

The information disclosure statement filed April 12, 1999, a PTO-1449 includes 8 sheets and they list numerous references, none of which have been submitted for the record. When copies of said references are submitted, the PTO-1449 will be completed, by the examiner, to avoid additional work for applicant.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Since the instant application 08/926,872 filed September 10, 1997, depends from application #08/631,613, filed April 10, 1996, and whereas an identical application, 08/926,194, does not depend on application #08/631,613, and another identical application 08/926,246, filed Sept. 5, 1997 also does not depend on application #08/631,613, the subject matter of the invention is obscured, and one can only speculate regarding what is the effective filing date of each application and what is included and excluded by the claims in 08/926,872, 08/926,194 and 08/926,246, which in substance are drawn to claimed subject matter that is identical in substance, and in terms also.

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Claims 1 and 3-8 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 08/926,194 and 08/926,246 which has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application. The examiner fails to see any difference in substance or terms between said claims and those in said applications.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Claims 1 and 3-8 of this application conflict with claims 1-8 of Application No. 08/926,194 and 08/926,246. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting

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claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claims 1 and 3-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Prouditt (5,314,187).

As understood, inherent features of the reference golf balls are claimed.

Claims 1 and 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prouditt.

Any possible distinctions over Prouditt's golf balls are deemed obvious arbitrary variants thereof simply to provide additional comparative examples.

Applicant's arguments with respect to claims 1 and 3-8 have been considered but are moot in view of the new ground(s) of rejection.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George J. Marlo whose telephone number is (703) 308-2094. The examiner can normally be reached on Mon-Thurs from 7:30 am to 7:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette E. Chapman, can be reached on (703) 308-1310. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3579.

Application/Control Number: 08/926,872

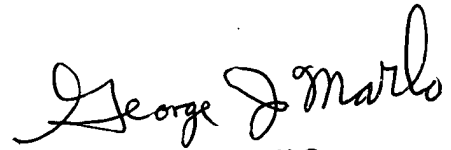
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Marlo/tnt

September 4, 1999

  
GEORGE J. MARLO  
PRIMARY EXAMINER  
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